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**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

In re) Case No. 05 CV 01114 JW
ACACIA MEDIA TECHNOLOGIES)
CORPORATION)
) **PLAINTIFF ACACIA MEDIA**
) **TECHNOLOGIES**
) **CORPORATION'S REPLY TO**
) **DEFENDANTS' RESPONSES TO**
) **THE ORDER APPOINTING**
) **RAINER SCHULZ AS A**
) **TECHNICAL CONSULTANT**
)
) **DATE:** N/A
) **TIME:** N/A
) **CTRM:** Hon. Howard R. Lloyd

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1 **I. INTRODUCTION**

2 Plaintiff Acacia Media Technologies Corporation (“Acacia”) hereby provides
3 this reply to the responses to Acacia’s objections to the reappointment of Mr. Rainer
4 Schulz as a technical advisor filed by defendants EchoStar Technologies Corporation
5 and EchoStar Satellite LLC (hereinafter the “EchoStar Response”) and defendant
6 Coxcom, Inc. (hereinafter the “Coxcom Response”).¹

7 To conform to Ninth Circuit and Federal Circuit law, this Court cannot
8 recommend that the Court adopt the June 21, 2005 Order without modification, as
9 proposed by defendants. The June 21 Order does not satisfy the procedural guidelines
10 for appointing technical advisors. Pursuant to the June 21 Order, Mr. Schulz’s duties
11 as a technical advisor (e.g., to tutor the Court as to meaning of scientific terms) are
12 not set forth in the Order (and therefore are not communicated to Mr. Schulz) and the
13 parties cannot learn the nature and content of Mr. Schulz’s communications to the
14 Court. There will be no record of the communications from Mr. Schulz to the Court
15 and thus no way for the parties or the reviewing court to know the basis for the
16 Court’s future decisions. Even though the Court has modified its prior Order to
17 specify that Mr. Schulz cannot make written findings of fact and cannot supply any
18 evidence to the Court, Mr. Schulz has already supplied evidence to the Court, the
19 specifics of which we are unaware. This is not how technical advisors are supposed
20 to be used.

21 Acacia’s concerns are real and are based on recent history. During the prior
22 Markman proceedings, the Court appointed Mr. Schulz as a technical expert. As a
23 technical expert, Mr. Schulz was not permitted to provide evidence to the Court; if he

25 ¹ The Coxcom Response is joined by defendants The DirecTV Group, Inc.;
26 Charter Communications, Inc.; Ademia Multimedia, LLC; AEBN, Inc.; Audio
27 Communications, Inc.; Club Jenna, Inc.; Cyber Trend, Inc.; Cybernet Ventures, Inc.;
28 ACMP, LLC; Game Link, Inc.; Global AVS, Inc.; Innovative Ideas International;
 Lightspeed Media Group, Inc.; National A-1 Advertising, Inc.; New Destiny Internet
 Group, LLC; VS Media, Inc.; International Web Innovations and Comcast Cable
 Communications, LLC.

1 did provide evidence to the Court, then Mr. Schulz would become subject to the
2 provisions of Rule 706, Fed.R.Evid.

3 It is clear that Mr. Schulz provided evidence to the Court. Based on the Court's
4 comments at the Case Management Conference and Mr. Schulz's time entries in his
5 invoices, the Court requested Mr. Schulz to perform claim construction analysis and
6 Mr. Schulz provided this analysis to the Court. Defendants argue that this is not the
7 case, but defendants ignore Mr. Schulz's time entries which state that he performed
8 "claim construction analysis." The fact that the parties so vigorously disagree as to
9 whether or not Mr. Schulz provided evidence to the Court based on the record that we
10 have, shows that a more complete record of Mr. Schulz's communications to the
11 Court is necessary to avoid these disputes in the future.

12 Both the Ninth Circuit and the Federal Circuit have held that district courts
13 must be extremely cautious when appointing a technical advisor so as to prevent
14 undue influence by the technical advisor on the court's decision-making function. If
15 the June 21 Order is adopted without modification, Mr. Schulz will have provided
16 evidence to the Court without the parties knowing what that evidence was and without
17 the parties having had an opportunity to depose Mr. Schulz. The record will never be
18 complete, because we will not know what Mr. Schulz communicated to the Court, and
19 appellate review will be difficult. It would be a shame for all the parties to go through
20 the effort of discovery and trial only to have this case remanded because the Order
21 appointing Mr. Schulz was improper.

22 Acacia therefore respectfully requests that the Magistrate Judge submit a
23 recommendation to Judge Ware indicating that the Court should only use Mr. Schulz
24 as an expert under Rule 706, Fed.R.Evid. so that the nature and content of Mr.
25 Schulz's advice is provided to the parties. Acacia also proposes procedural
26 safeguards to assure that, if Mr. Schulz is deposed, the Court's mental processes and
27 impressions are not revealed to the parties.

1 If the Court is not willing to make such modification to the Order, then the
2 Magistrate Judge should recommend that the Court not use a technical advisor in this
3 case.

4 **II. DEFENDANTS CANNOT SERIOUSLY CONTEND THAT MR.
5 SCHULZ COMPLIED WITH HIS DUTIES AS A TECHNICAL
6 ADVISOR AND DID NOT PROVIDE EVIDENCE TO THE COURT**

7 Mr. Schulz has not complied with his duties as a technical advisor. The role of
8 a technical advisor is to help the Court understand relevant scientific evidence, that is,
9 to act a tutor. *FTC v. Enforma Natural Products, Inc.*, 362 F.3d 1204, 1213 (9th Cir.
10 2004); *Techsearch LLC v. Intel Corp.*, 286 F.3d 1360, 1377 (Fed. Cir. 2002).

11 Technical advisors do not provide evidence to a court, and certainly do not instruct a
12 court as to how to construe a claim term. Claim construction is not a technical issue;
13 it is an issue of law for a court to decide. *Markman v. Westview Industries, Inc.*, 517
14 U.S. 370, 391 (1996); *FTC v. Enforma*, (“A technical advisor may not assume the role
15 of an expert witness by supplying new evidence, nor may an advisor usurp the role of
16 the judge by making findings of fact or conclusions of law.”)

17 Yet, in his invoice entries, Mr. Schulz informed the parties that he performed
18 “claim construction analysis” and that he met with the Court prior to the Court issuing
19 its Markman Order. (See, Acacia’s Objections, at 4:11-26; Exhibits 3 and 4 to Block
20 Decl.). According to the April 7, 2004 Order (Exhibit 2 to Block Decl.), Mr. Schulz
21 would only serve as a consultant “at the request of the Court.” The Court hired Mr.
22 Schulz to assist the Court with this case and Mr. Schulz billed the parties at \$200/hour
23 for his claim construction analysis. The only inference which could therefore
24 reasonably be reached from the April 7 Order, from Mr. Schulz’s time entries in his
25 invoices, and from the Court’s comments at the Case Management Conference is that

1 the Court had requested Mr. Schulz to perform claim construction analysis and that
2 Mr. Schulz communicated his claim construction analysis to the Court.²

3 Because Mr. Schulz provided a “claim construction analysis” to the Court, Mr.
4 Schulz provided evidence to the Court, in the form of an expert opinion pursuant to
5 Rule 702, Fed.R.Evid. Thus, Mr. Schulz lost his status as a technical advisor and
6 became subject to the requirements of Rule 706, Fed.R.Evid. *FTC v. Enforma*, 362
7 F.3d at 1212-13 (“A court-appointed expert is a witness subject to Rule 706 if the
8 expert is called to testify or if the court relies on the expert as an independent source
9 of evidence.... If Dr. Heber offered independent evidence as an expert witness, he
10 should have been subject to cross-examination about the information he relied upon in
11 forming his opinions. See, Fed.R.Evid. Rule 706”).³

12 Acacia’s objection to the appointment of Mr. Schulz as a technical advisor and
13 request that he be appointed as an expert pursuant to Rule 706, Fed.R.Evid. Is
14 therefore entirely proper.⁴

16 ² It would be unreasonable to infer that Mr. Schulz performed his claim
17 construction analysis on his own, without a request from the Court or that Mr. Schulz
18 performed the claim construction analysis, but did not provide that analysis to the
19 Court. The Court hired Mr. Schulz to assist the Court and he would not perform
work, or bill the parties for work, not requested by the Court. He also would not bill
the parties for work requested by the Court, but that he did not supply to the Court.

20 ³ In its response, Coxcom contends that the cases relied on by Acacia hold that
21 Rule 706 does not apply to technical advisors. (Coxcom’s Response, at 4:7-10).
22 Each case also addressed the issue of whether the technical advisor had provided
evidence to the court; if so, the technical expert would become subject to the
provisions of Rule 706.

23 ⁴ Coxcom also contends that Acacia’s request to designate Mr. Schulz would
24 thwart the Court’s purpose to appoint a technical advisor. Acacia is not “thwarting”
25 the Court’s purpose, but instead would be fulfilling the Court’s goal of having a
26 technical expert provide their opinions regarding technical issues in the case, such as
27 the meaning of claim terms, without having that person reveal the Court’s
communications or mental impressions at a deposition. If Coxcom contends that the
Court’s purpose is to have a technical advisor who provides opinions to the Court on
claim construction, but who is not subject to the provisions of Rule 706 and whose
communications to the Court cannot be placed in the record, then Acacia needs to
make clear that this is not permitted, and the Court should not have such a technical
advisor under these conditions.

1 **A. Defendants Ignore the Fact that Mr. Schulz's Invoices State that He**
2 **Performed Claim Construction**

3 In both of their responses, defendants completely ignore Mr. Schulz's invoice
4 entries regarding "claim construction analysis," as though those entries never existed.
5 In its response, Coxcom does not even mention or acknowledge Mr. Schulz's invoice
6 entries. Instead, Coxcom states, without support, that "the record reflects that the
7 Court properly used Mr. Schulz as a consultant on the issues regarding the technology
8 involved in the case in regard to the *Markman* analysis." (Coxcom Response, at 3:22-
9 24).

10 In reality, the opposite is true. The record reflects that Mr. Schulz, acting on
11 behalf of the Court and at the Court's request, performed claim construction analysis
12 and met with the Court prior to the Court issuing its Markman Order. The record
13 therefore actually reflects that the Court did not properly use Mr. Schulz as a
14 technical consultant.

15 In its response, EchoStar at least mentions Mr. Schulz's invoice entries.
16 EchoStar, however, conspicuously omits the entries relating to "claim construction" in
17 asserting that Mr. Schulz acted only as a technical advisor, and not a Rule 706 expert:

18 EchoStar notes that the time entries for Mr. Schulz appear to
19 indicate that he did precisely what one would expect of a technical
20 consultant, including reviewing the patents, analyzing the claims,
21 and reviewing the papers submitted in connection with the
22 *Markman* hearing. (EchoStar Response, at 3 n 2).

23 EchoStar's statement that Mr. Schulz did what would be expected of a technical
24 consultant, because Mr. Schulz "analyzed" the claims is wrong. One would not
25 expect a technical consultant to "analyze claims." Technical consultants are tutors
26 who assist the Court in understanding relevant scientific evidence. Patent claims are
27 legal instruments which are to be "analyzed" and construed by the Court; patent
28 claims are not scientific evidence. Mr. Schulz was "analyzing" claims for the purpose

1 of Markman claim construction proceedings, and therefore was acting as an expert
2 under Rule 706, not a technical consultant.

3 EchoStar would even have the Court believe that Mr. Schulz did nothing more
4 than review documents and meet with the Court:

5 The invoices indicate only that Mr. Schulz acted appropriately by,
6 for example, reviewing documents and meeting with the Court.
7 (EchoStar response, at 8:23-24).

8 **B. There is Evidence in the Markman Order that the Court Relyed on
9 Extra-Record Evidence Which Could Only Have Been Provided by
10 Mr. Schulz**

11 Defendants contend that Acacia is merely speculating when it contends that Mr.
12 Schulz provided evidence to the Court (in the form of an expert opinion as to the
13 meaning of claim terms to a person of ordinary skill in the art). In its response,
14 Coxcom contends that “[t]he Court’s explicit statements in its Markman Order
15 evidence no reliance on testimony from Mr. Schulz in the past . . .” (Coxcom
16 Response, at 4:14-15). Coxcom takes two sentences regarding the terms “sequence
17 encoder” and “identification encoder” from the 40-page Markman Order to support
18 this broad contention. (Coxcom Response, at 3:13-24). Further, Coxcom does not
19 cite to any evidence of record on which the Court could have relied to support its so-
20 called findings in the Markman Order.

21 In its response, EchoStar states, without support, that “[t]he Markman Order is
22 consistent with Federal Circuit law requiring that claims be construed according to the
23 understanding of those of skill in the art.” (EchoStar’s Response, at 8:26-27). This is
24 not a correct description of the Markman Order, because like Coxcom, EchoStar fails
25 to cite any evidence of record which would support EchoStar’s contention or support
26 the Court’s findings.

27 Acacia’s examples of instances where the Court’s statements in the Markman
28 Order were not based on the evidence of record, but necessarily were based on expert

1 testimony from Mr. Schulz, included not only the Court's statements regarding
2 "sequence encoder" and "identification encoder," but also the claim terms "in data
3 communication with" and "transmission system at a first location." (Acacia's
4 Objections, at 4:27 – 6:5). No defendant addressed these other terms.

5 With respect to all of these claim terms, the Court made so-called findings as to
6 the understanding of "one of ordinary skill in the art," but did not cite to the evidence
7 of record to support such findings. In each instance, the Court could not have known
8 from the record what one of ordinary skill would have understood or not understood
9 about the claim terms, because the Court did not allow expert testimony during this
10 phase of the Markman proceedings. One of the reasons given by the Court for
11 allowing reconsideration of the Markman Order was to allow the parties to present
12 expert testimony on these issues.

13 The Court could only have made its "findings" as to the understanding of one
14 of ordinary skill in the art based on evidence received from Mr. Schulz. This is
15 logical, because Mr. Schulz provided the Court with his claim construction analysis,
16 which likely included evidence as to the understanding of one of ordinary skill in the
17 art.

18 **C. The Appellate Court Cannot Assume that the Court Properly
19 Utilized Mr. Schulz as a Technical Consultant**

20 EchoStar contends in its response that "in the absence of evidence to the
21 contrary, the Ninth Circuit assumes that district courts properly utilize technical
22 consultants. *See, AMAE*, 231 F.3d at 591." (EchoStar Response, at 8:19-20).

23 Here, there is evidence that the Court did not properly utilize Mr. Schulz as a
24 technical consultant, and therefore the Federal Circuit Court of Appeals (who will
25 handle the appeal of this case) cannot assume that the Court had properly utilized Mr.
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1 Schulz.⁵ As discussed above, from the evidence of record, including Mr. Schulz's
2 invoices and the Court's findings in the Markman Order, it is evident that, at the
3 Court's request, Mr. Schulz performed claim construction and communicated his
4 claim constructions to the Court prior to the Court issuing its Markman Order.

5 There is evidence in the record that the Court did not properly use Mr. Schulz
6 as a technical expert, and therefore, the Federal Circuit will not assume that the Court
7 properly utilized Mr. Schulz.

8 **D. The Fact that the Court Has Allowed Reconsideration of its
9 Markman Order Does Not Erase the Past**

10 In both responses, defendants contend that, even if Mr. Schulz provided
11 evidence to the Court, Acacia has a suitable remedy, because the Court has allowed
12 Acacia to file a motion for reconsideration of the Markman Order as to any term
13 construed in the Markman Order. (See, Coxcom's Response, at 3:25-4:3; EchoStar's
14 Response, at 9:4-7).

15 Reconsideration of the Markman Order is not an adequate remedy to eliminate
16 the prejudice to the parties caused by the fact that Mr. Schulz provided evidence to the
17 Court prior to the Court issuing its Markman Order. Pursuant to Rule 706, the parties
18 are permitted to depose Mr. Schulz to learn what opinions he provided to the Court.

19 See, *FTC v. Enforma*, 362 F.3d at 1212-14. The motion for reconsideration does not
20 provide the parties this right. As a result, on appeal, there will be no record for the
21 appellate court to understand how the Court reached its decisions. The lack of a
22 sufficient record to afford appellate review of the Court's claim construction may
23 itself be grounds for remand by the Federal Circuit. See, *Nazomi Communications*,

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25
26 ⁵ The Federal Circuit will not necessarily assume that the Court used Mr. Schulz
27 properly, even in the absence of evidence to the contrary. The Federal Circuit has
held that "the federal courts of appeal must determine the extent, if any, to which a
district court has established safeguards to prevent the technical advisor from
introducing new evidence and to assure that the technical advisor does not influence
the district court's review of the factual disputes." *Techsearch*, 286 F.3d at 1377.

1 *Inc. v. ARM Holdings, PLC*, 403 F.3d 1364, 1371 (Fed. Cir. 2005), quoting, *Gechter*
2 *v. Davidson*, 116 F.3d 1454, 1458 (Fed. Cir. 1997) (“Moreover, in order to perform
3 such a review [of a district court’s claim construction ruling], this court must be
4 furnished ‘sufficient findings and reasoning to permit meaningful appellate
5 scrutiny.’”) If Mr. Schulz is appointed as a Rule 706 expert, there will be a record of
6 his opinions and the parties will be permitted to depose Mr. Schulz.

7 Further, reconsideration of the Markman Order means that the Court will likely
8 presume that its prior findings and decisions are the proper claim construction, unless
9 Acacia can overcome the Court’s presumed constructions. In *FTC v. Enforma*, the
10 remedy was to vacate the preliminary injunction that was tainted by the Court’s
11 misuse of the technical expert. In this case, however, the Court has not vacated its
12 prior Markman Order.

13 The only remedy available is found in the Rules of Evidence; the Court must
14 designate Mr. Schulz as an expert pursuant to Rule 706, Fed.R.Evid.

15 **III. THE JUNE 21, 2005 ORDER IS NOT A PROPER APPOINTMENT OF A
16 TECHNICAL ADVISOR, BECAUSE THE ORDER DOES NOT
17 SATISFY THE RELEVANT PROCEDURAL GUIDELINES**

18 EchoStar contends in its response that the June 21 Order appointing Mr. Schulz
19 satisfies the procedural guidelines for appointing technical advisors endorsed by the
20 Ninth Circuit in the *FTC* case. (EchoStar Response, at 7:15-17).⁶ This is not the case.

21 The appointment of any technical advisor automatically raises concerns that the
22 technical advisor will usurp the judicial decision-making function of the court.

23 *Techsearch*, 286 F.3d at 1379 (“The fact that the use of a technical advisor is
24 permissible under such guidelines [Judge Tashima’s guidelines] does not mean that it
25 is invariably desirable or that safeguards are not required. As a practical matter, there

27 ⁶ In its response, Coxcom does not address whether the Order satisfies the
28 procedural guidelines for appointing technical advisors endorsed by the Ninth Circuit
 in the *FTC* case. Instead, Coxcom focuses on Acacia and Acacia’s contentions.

1 is a risk that some of the judicial decision-making function will be delegated to the
2 technical advisor. District court judges need to be extremely sensitive to this risk and
3 minimize the potential for its occurrence.”)

4 For this reason, the Ninth Circuit and the Federal Circuit have endorsed the use
5 of the five procedural safeguards described by Judge Tashima in his dissent in *AMAE*
6 when appointing technical consultants. *FTC v. Enforma*, 362 F.3d at 1215 (“Judge
7 Tashima’s recommendations include the following procedural steps: (1) utilize a fair
8 and open procedure for appointing a neutral technical advisor; (2) address any
9 allegations of bias, partiality, or lack of qualification; (3) clearly define and limit the
10 technical advisor’s duties; (4) make clear to the technical advisor that any advice he or
11 she gives to the court cannot be based on any extra-record information; and (5) make
12 explicit, either through an expert’s report or a record of ex parte communications, the
13 nature and content of the technical advisor’s advice. *AMAE*, 231 F.3d at 611-14
14 (Tashima, J., dissenting).”)⁷

15 The Court’s June 21 Order does not satisfy the procedural guidelines for
16 appointing technical advisors, as EchoStar contends.

17 The Order does not clearly define and limit the technical advisor’s duties
18 (safeguard no. 3). EchoStar contends that the fact that the June 21 Order states that
19 Mr. Schulz will be limited to the “technology issues in these cases,” means that this
20 safeguard is met. (EchoStar’s Response, at 6:18-20). Nothing in this description,
21 however, limits Mr. Schulz to the proper scope of a technical advisor’s role, as
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25 In *Techsearch*, the Federal Circuit stated that these guidelines “propose broad
26 criteria for minimally safeguarding the judicial process and the district court from
27 undue influence by the technical advisor and to ensure that the technical advisor’s role
28 is properly limited to a tutoring function. . .” *Techsearch*, 286 F.3d at 1379. In *FTC*
v. *Enforma*, the Ninth Circuit stated that these guidelines would “assure the parties
that the court is proceeding openly and fairly” and would “aid in appellate review if
such review becomes necessary.” *FTC v. Enforma*, 362 F.3d at 1214.

1 described in *Techsearch*.⁸ In *Techsearch*, the Federal Circuit stated that this
2 safeguard would “ensure that the technical advisor’s role is properly limited to a
3 tutoring function and providing technical education and background information in
4 the technology to the court.” *Techsearch*, 286 F.3d at 1379.

5 The Order does not make clear to the technical advisor that any advice he gives
6 to the Court cannot be based on any extra-record information (safeguard no. 4).⁹

7 The Order does not provide that Mr. Schulz shall make explicit, either through
8 an expert’s report or a record of *ex parte* communications, the nature and content of
9 Mr. Schulz’s advice (safeguard no. 5).¹⁰ The fact that the Court has not provided the
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11 ⁸ In the portion of its Proposed Order accompanying its motion for clarification
12 regarding technical consultants, Acacia proposed the following language to define and
13 limit Mr. Schulz’s role as a technical consultant: “1. From time-to-time, at the
14 request of the Court, Mr. Schulz will serve as an independent, neutral technical
15 advisor for the Court to assist the Court to understand relevant technical evidence
16 pertinent to the patents-in-suit. Specifically, Mr. Schulz shall assist the Court in
17 educating itself in the terminology and theory disclosed by the evidence as the Court
18 deems necessary. Mr. Schulz will act as a sounding board for the Court to think
19 through the technological significance of the evidence, and will assist the Court in
20 determining the validity of any scientific evidence, hypothesis or theory on which any
other expert bases their testimony. Mr. Schulz shall only provide advice that is
consistent with generally accepted knowledge in the relevant area. . . . 3. Mr. Schulz
shall not: a. be an advocate on behalf of either party; b. contribute evidence, either
by testimony or in writing, or render conclusions of law; c. offer to the Court an
opinion about the ultimate legal issues in these actions, i.e., the construction of any
claim term of any patent-in-suit, the validity of any claim of any patent-in-suit, or
whether any of the claims of the patents-in-suit are infringed by the accused products;
d. conduct any independent investigation of any issue pertinent to the litigation.”
(See, Acacia’ Motion, at 18:8 – 20:2; Exhibit 9 to Block Decl.).

21 ⁹ The EchoStar defendants suggest revising the Order appointing Mr. Schulz to
22 add language stating that Mr. Schulz should be limited to the information in the
record. (See, EchoStar Response at 7:1-2). This revision would comply with the
23 fourth safeguard set forth by Judge Tashima.

24 ¹⁰ In the portion of its Proposed Order accompanying its motion for clarification
25 regarding technical consultants, Acacia proposed the following language to require
26 that the nature and content of Mr. Schulz’s communications to the Court be
27 communicated to the parties: “Consistent with the nature of his engagement, the
Court has had, and anticipates having, direct *ex parte* communications with Mr.
Schulz. The Court shall provide the parties with a summary of the nature and scope
of the advice given by Mr. Schulz during all such communications, both prior to this
Order and subsequent to this Order (except comments by Mr. Schulz on drafts of the
Court’s own opinions). Additionally, the Court has asked, and may in the future ask,
Mr. Schulz to prepare written submissions for the court. A copy of any such
submission will be provided to the parties (except written comments by Mr. Schulz on

1 parties with a record of Mr. Schulz's communications to the Court (even after this has
2 been requested by one of the parties) may exacerbate any concerns that the appellate
3 court may have that Mr. Schulz played an improper role in the Court's decisions.

4 *FTC v. Enforma*, 362 F.3d at 1214 ("The district court's failure to make a record of
5 Dr. Heber's conclusions exacerbates our concern that Dr. Heber may have played an
6 improper role in the district court's decision."¹¹)

7 EchoStar contends that this safeguard is met by Mr. Schulz's invoices, which
8 provide narrative entries, and suggests the Order be modified to require Mr. Schulz to
9 continue providing such invoices. (EchoStar's Response, at 7:7-8). Mr. Schulz's
10 "narrative entries" merely identify a task performed by Mr. Schulz, such as "claim
11 construction analysis." Such narrative entries do not make explicit the nature and
12 content of Mr. Schulz's advice. If anything, Mr. Schulz's invoice entries raise more
13 questions than they answer: what claim terms did Mr. Schulz analyze? what was the
14 construction he communicated the Court?

15 **A. The Fact that the Court Added the Limitations to the Order that Mr.
16 Schulz is Precluded from Making Written Findings of Fact and From
17 Supplying Evidence to the Court Are Insufficient**

18 In both responses, defendants contend that the June 21 Order meets the
19 procedural guidelines, because, in the Order, the Court has added limitations
20 precluding Mr. Schulz from making any written findings of fact or supplying any

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24 drafts of the Court's own opinions). Should any party believe that any such
25 communication or written communication contains errors of fact, that party may so
advise the Court in writing." (See, Acacia' Motion, at 20:5-18; Exhibit 9 to Block
Decl.).

26 ¹¹ See also, *AMAE*, 231 F.3d at 614 (Judge Tashima, dissenting) ("Whatever
27 method the court employs in making a record of the technical advisor's advice and
counsel, there is no reason why a neutral technical advisor's advice should be
shrouded in absolute secrecy. Concealing the nature of that expert advice can only
erode confidence in the court's role as a neutral and independent decisionmaker.")

1 evidence to the Court. (Coxcom's Response, at 4:4-6; EchoStar's Response, at
2 6:17-25).

3 While these provisions do provide some level of comfort, they are basically
4 meaningless, given the Court's refusal to make explicit, either through an expert's
5 report or a record of *ex parte* communications, the nature and content of Mr. Schulz's
6 advice (safeguard no. 5). Without some record of communications from Mr. Schulz
7 to the Court, Mr. Schulz can say anything he wants to the Court without the parties'
8 knowledge. Neither the parties nor the appellate court will have any means of
9 knowing whether Mr. Schulz and the Court have complied with this limitation. Given
10 the evidence that we do have from Mr. Schulz's invoices showing that, at the Court's
11 request, Mr. Schulz performed claim construction analysis and provided that to the
12 Court, we now know the manner in which the Court has used Mr. Schulz previously,
13 even in instances where designated as a technical consultant.

14 Further, the fact the Mr. Schulz will now also be required to provide a
15 declaration stating that he will adhere to the terms of his appointment before he
16 commences additional work is also of little use. Mr. Schulz cannot know now
17 whether he will provide evidence in the future. Mr. Schulz is not an attorney and
18 likely does not understand what constitutes "evidence." Further, because the Order
19 does not set forth specifically Mr. Schulz's role as a technical advisor (as only a
20 technology tutor, for example), Mr. Schulz will not sufficiently know the boundaries
21 of his appointment. Presumably, Mr. Schulz has not read the relevant case law or the
22 parties' legal briefs.

23 **IV. CONCLUSION**

24 For the forgoing reasons, Acacia objects to the Court's appointment of Mr.
25 Schulz, as set forth in the June 21, 2005 Order and respectfully requests that Acacia's
26 proposed relief be granted and the Magistrate Judge submit a recommendation to
27 Judge Ware indicating that the Court should only use Mr. Schulz as an expert under
28

1 Rule 706, Fed.R.Evid. or, if not, then indicating that the Court should not use a
2 technical advisor in this case.

3

4 DATED: July 25, 2005

HENNIGAN BENNETT & DORMAN LLP

5

6 By _____ /s/
7

8 Roderick G. Dorman
9 Alan P. Block
10 Kevin I. Shenkman
11 Attorney for Plaintiff
12 ACACIA MEDIA TECHNOLOGIES
13 CORPORATION

PROOF OF SERVICE

I, Sylvia A. Berson, declare:

I am a citizen of the United States and employed in Los Angeles County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On July 25, 2005, I served a copy of the within document(s) described as **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S REPLY TO DEFENDANTS' RESPONSES TO THE ORDER APPOINTING RAINER SCHULZ AS A TECHNICAL CONSULTANT** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document(s) listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on the attached Service List.

I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on **July 25, 2005**, at Los Angeles, California.

/S/

Sylvia A. Berson

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